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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,710	05/25/2006	Jean-Michel Claude Gaston Savignat	TS6449US	8869

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SHELL OIL COMPANY
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EXAMINER

BOMAR, THOMAS S

ART UNIT	PAPER NUMBER
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3676

MAIL DATE	DELIVERY MODE
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12/28/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/580,710

Applicant(s)

SAVIGNAT ET AL.

Examiner

Shane Bomar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 5/25/06.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed May 25, 2006 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. Specifically, the Examiner is referring to document number 02/07994 that is for an automobile tire, which is no way related to the current invention. It has been placed in the application file, but the information referred to therein has not been considered.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the control means and releasable locking means must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 3.

4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure

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must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

5. Claims 10 and 17 are objected to because of the following informalities: in claim 10, the word --a-- should be added after "in" at the end of the first line; in claim 17, the recitation of "as scraper" should be --as a scraper--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3 and 7-18 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,141,063 to Quesenbury.

Regarding claims 1 and 9, Quesenbury discloses a method of removing a body of selected material from the interior of a casing 11 extending into a borehole formed in an earth formation (Fig. 6), the method comprising: a) lowering a drill bit 2 for further drilling of the borehole, into the casing, the drill bit having a longitudinal axis of rotation during operation, the drill bit comprising rock cutting means 5, at least one protection member 6 for protecting the inner surface of the casing from contact with the rock cutting means, each protection member being adapted to remove said selected material from the interior of the casing and being radially movable towards the inner surface of the casing, and control means 17 for applying a radially outward force of controlled magnitude to the protection member; b) rotating the drill bit in the casing; and c) operating the control means so as to apply said radially outward force of controlled magnitude to the protection member (Figs. 3 and 4; col. 4, lines 26-53).

Regarding claims 2, 3, and 10, the drill bit comprises a reamer arm 3 movable in radial direction relative to said axis of rotation, wherein the rock cutting means 5 and each protection member 6 are provided at the reamer arm, and wherein step c) comprises operating the control means so as to move the reamer arm in radially outward direction relative to the axis of rotation by controlling the rate of fluid pumped to the control means (col. 5, lines 31-67).

Regarding claim 4, the drill bit is axially moved through the casing simultaneously with steps b) and c) (col. 3, lines 5-15).

Regarding claims 7, 8, and 19, the body of selected material includes a body of cement located in a lower end portion of the casing, and the body of selected material extends into a lower end portion of the casing, said lower end portion having a larger inner diameter than a remainder portion of the casing that contains the restriction 1 (Fig. 6).

Regarding claims 11 and 12, releasable locking means 10 is released by the action of the control means (col. 5, lines 23-30).

Regarding claims 13-15, the protection member 6 is formed as an integral part of the reamer arm 3, and wherein the reamer arm is provided with gauge protection means 7 for protecting the reamer arm against wear during further drilling of the borehole with the drill bit, and wherein the protection member is arranged on top of the gauge protection means at the radially outward side thereof (Figs. 1-4; col. 4, lines 53-60).

Regarding claims 16 and 17, the protection member 6 is rounded when viewed from the top to match the circumference of the casing and/or the borehole being drilled (Fig. 5), and the member 6 is a scraper (col. 4, lines 45-50).

Regarding claim 18, the protection member is adapted to substantially vanish due to wear during drilling into the earth formation with the drill bit, as is notoriously known in the art for drilling elements to do over time (see also col. 7, lines 31-42).

8. Claims 1, 4-7, 9, 17, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by US 2,857,141 to Carpenter.

Regarding claims 1 and 9, Carpenter discloses a method of removing a body of selected material from the interior of a casing 12 extending into a borehole formed in an earth formation (Fig. 2), the method comprising: a) lowering a drill bit 10 for further drilling of the borehole, into the casing, the drill bit having a longitudinal axis of rotation during operation, the drill bit comprising rock cutting means attached to element 20, at least one protection member 28 for protecting the inner surface of the casing from contact with the rock cutting means, each protection member being adapted to remove said selected material from the interior of the casing

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and being radially movable towards the inner surface of the casing, and control means 34 for applying a radially outward force of controlled magnitude to the protection member; b) rotating the drill bit in the casing; and c) operating the control means so as to apply said radially outward force of controlled magnitude to the protection member (Figs. 1- 4; col. 2).

Regarding claims 4-7, 17, and 19, the bit is moved axially, either upwardly or downwardly, to remove the annular portion of the cement left on the walls of the casing after the cement was initially drilled through (col. 3, lines 20-59).

Conclusion

9. The prior art made of record on form 892 and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shane Bomar whose telephone number is 571-272-7026. The examiner can normally be reached on Monday - Thursday from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer Gay can be reached on 571-272-7029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (In USA or Canada) or 571-272-1000.

/Shane Bomar/
Patent Examiner
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December 19, 2007